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EXAMINER

SHAN, APRIL YING

ART UNIT

PAPER NUMBER

2435

MAIL DATE

DELIVERY MODE

11/12/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/671,463	Applicant(s) FUJIWARA ET AL.	
	Examiner APRIL Y. SHAN	Art Unit 2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-11,13-19 and 22-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-11,13-19 and 22-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The Applicant's amendment, filed 08 August 2008, has been received, entered into the record, and respectfully and carefully considered.
2. As a result of the amendment, claims 1, 6-7, 17, 19, 27-29 and 31-32 have been amended. Claims 4-5, 12 and 20-21 are canceled. Claims 1-3, 6-11, 13-19 and 22-32 are now presented for examination.
3. Any claim objection/rejection not repeated below is withdrawn due to Applicant's amendment.

Information Disclosure Statement

4. Japanese non-patent literature "Inter-Q: Providing Advertising Display Functions to Providers" is considered.

The examiner carefully searched "bottom right hand corner of the submitted document" (as instructed by the Applicant's remark page 12) of "Hot Spots That Can Turn a Street Corner into an Office," Telecommunications, No. 219, October 2002, it appears to the examiner pages 26-27 are still missing. It has been placed in the application file, but the information referred to therein has not been considered.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1, 3, 6-7, 15-17, 19, 22-23 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takada et al., (U.S. Pub. No. 20020089931) in view of Applicant's admitted prior art by Jun (Japanese Patent Laid-open 2001-266018. The below rejections are based on the Machine English translation copy provided by Japanese Patent Office).

As per **claims 1 and 17**, Takada et al. discloses an internet connection service providing method/system, comprising:

presetting a service class, among a plurality of service classes, for a user, wherein said service class is selected by the user (“...A DS class...TS class...BE class...” – e.g. par. [0007] – [0009], “In the conventional example having the above configuration, the band monitoring part 51 is informed in advance of a transmission bandwidth (hereinafter referred to as "contracted bandwidth") that the user of the above-mentioned terminal, for example, requested at the time of contract” – e.g. par. [0012] and fig. 8);

authenticating said user, when logging in to a network, according to said preset service class for said user (“Every time receiving a packet (hereinafter referred to "new packet") from each terminal, the band monitoring part 51 performs a rate-based congestion control (mean policing) by performing the following series of operations: (1) Identifies a flow (including the identifier of a sender) to which the new packet belongs by referring to a prescribed field of the new packet. (2) Acquires a contracted bandwidth of the sender terminal. (3) Judges, according to a prescribed algorithm such as the leaky bucket algorithm, whether the rate (average rate) of packets belonging to the identified flow exceeds the contracted bandwidth..” – e.g. par. [0012] – [0015] and fig. 9);

recognizing said preset service class for said user and providing a service, corresponding to the recognized service class, to said user (“As shown in FIG. 9, a sequence of packets that are sent from a terminal accommodated in the local station

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(or packets received from a preceding transmission section) is supplied to the input of a band monitoring part 51.

The output of the band monitoring part 51 is directly connected to the input of a congestion controlling part 52. The congestion controlling part 52 has outputs corresponding to respective service classes (for simplicity, it is assumed here that they are the above-described DS (delay sensitive) type, TS (throughput sensitive) type, and BE (best effort) type service classes) to which the packets may belong. The outputs of the congestion controlling part 52 are directly connected to the inputs of queues 53-1 to 53-3 that correspond to the respective service classes. The outputs of the queues 53-1 to 53-3 are connected to respective ports of a packet switch (not shown; or a line interfacing part). The control terminals of a scheduler 54 that plays a leading role in reading (first-in first-out) of the queues 53-1 to 53-3 are directly connected to the read control terminals of the queues 53-1 to 53-3, respectively... Passes the new packet to the congestion controlling part 52 when the judgment result is false.” – e.g. par. [0011] – [0017]).

Takada et al. does not expressly disclose wherein advertisement data which have been preliminarily received from an advertisement requester and accumulated are distributed to said users in correspondence to said service class.

However, this well known feature of advertisement data which have been preliminarily received from an advertisement requester and accumulated are distributed to said users in correspondence to said service class is disclosed in Jun (e.g. “it connected with...**while generating said service information based on said**

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customer information memorized beforehand and transmitting said service information to said consumer premise equipment” – e.g. claim 12 and par. [0030] – [0032]).

It would have been obvious to a person with ordinary skill in the art at the time of the invention that Jun's customer information can include Takada et al.'s user service class information and incorporating Jun's advertisement data which have been preliminarily received from an advertisement requester and accumulated are distributed to said users in correspondence to said service class into Takada et al. motivated by increasing an opportunity to supply the advertisement of own goods to a customer according to a demand of a customer (Jun, par. [0030] and [0032]).

As per **claims 3 and 19**, Takada et al. – Jun discloses a method/system as applied above in claims 1 and 17. Takada et al. further discloses wherein said service class is preset for said user on the basis of a contract (e.g. par. [0012]).

As per **claim 6**, Jun further discloses wherein utilization or communication service fees concerning the distribution of the advertisement data to said user is covered by advertisement fee paid by the advertisement requester to the ISP based on advertisements as the subject of the request (e.g. paragraph [0031]).

As per **claim 7**, Jun further discloses wherein the advertisement data preliminarily received from the advertisement requester and accumulated are further distributed to said based on advertisement distribution requests therefrom (e.g. paragraph [0050], [0055]).

As per **claim 15**, Takada et al. – Jun discloses a method as applied above in claim 1. Takada et al. further discloses wherein said provided service is classified by predetermined communication qualities (e.g. fig. 8 and par. [0004] – [0009]).

As per **claim 16**, Takada et al. – Jun discloses a method as applied above in claim 1. Takada et al. further discloses wherein said provided service is classified based on a kind of preset accessible media and protocol (e.g. fig. 8 and par. [0004] – [0009]).

As per **claims 22-23**, Jun further discloses comprises an advertisement distributing server for accumulating advertisement data preliminarily received from advertisement requester and distributing the accumulated advertisement data to said user (e.g. paragraph [0050]), the advertisement distributing server being applicable to distribute advertisement data to said user corresponding to said service class data (e.g. paragraph [0050]), wherein the service server is arranged such as not to charge any fee for advertisement distribution and communication services required therefor to said user (e.g. abstract and paragraph [0050]), wherein the service server includes a service class correspondence table for managing the plurality of service classes such as to fit advertisement distribution requests each from said user and a fee managing table for managing fees for said user (e.g. paragraph [0031] and [0050]), and distributes advertisement data received from an advertisement requester and accumulated to said user based on the service class correspondence table to meet said user's advertisement distribution requests (e.g. paragraph [0050]).

As per **claim 32**, Takada - Jun discloses a system as applied above in claim 17. Takada - Jun further discloses comprises an access control unit for limiting communication media according to preset sections provided for said user's service class, and the service server includes a media managing table, in which an accessible media and a protocol are defined for each service class (e.g. paragraph [0028] of Jun and fig. 8, par [0004] – [0009] of Takada).

9. Claims 2 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takada et al., (U.S. Pub. No. 20020089931) in view of Applicant's admitted prior art by Jun (Japanese Patent Laid-open 2001-266018. The below rejections are based on the Machine English translation copy provided by Japanese Patent Office) and further in view of De Cnodder et al. (U.S. Pub. No. 20030048791).

As per **claims 2 and 18**, Takada et al. – Jun discloses a method/system as applied above in claims 1 and 17. Takada et al. further implicitly discloses wherein a fee corresponding to the service class is computed based on fee managing data and charged to said user by disclosing contracted bandwidth at the of contract (e.g. par. [0012]).

Takada et al. – Jun does not expressly disclose wherein a fee corresponding to the service class is computed based on fee managing data and charged to said user.

However, De Cnodder et al. discloses wherein a fee corresponding to the service class is computed based on fee managing data and charged to said user ("...supports a plurality of service classes, such that Internet Service Providers can implement a

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pricing strategy which respect to the plurality of service classes...at a high cost...at an average cost...at a low cost..." – e.g. par. [0001], [0004] and [0005]).

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate De Cnodder et al.'s wherein a fee corresponding to the service class is computed based on fee managing data and charged to said user into Takada et al. – Jun motivated by "the Internet Service Providers (ISPs) can differentiate their services, and implement different pricing strategies, such that a better class of service will cost the end user more money" (De Cnodder et al. par. [0005])

10. Claims 8-10, 13-14 and 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takada et al., (U.S. Pub. No. 20020089931) - Applicant's admitted prior art by Jun (Japanese Patent Laid-open 2001-266018. The below rejections are based on the Machine English translation copy provided by Japanese Patent Office) as applied above in claim 7, further in view of Hou (Japanese 2001-111727A. The below rejections are based on the Machine English translation copy provided by Japanese Patent Office).

As per **claim 8**, Takada et al. – Jun does not expressly discloses wherein an amount obtained by subtracting an advertisement reading fee corresponding to the number of times and frequency of advertisement reading from the internet connection service fee is charged.

However, Hou discloses wherein an amount obtained by subtracting an advertisement reading fee corresponding to the number of times and frequency of

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advertisement reading from the internet connection service fee is charged ("Especially this invention relates to the portable telephone-rates discount method and equipment using the Internet about the method of charge discount service offer of the telephone (for example, cellular-phone or PHS phon) charge for mobile communications for internet advertising activation" – e.g. par. [0001], "if people with a radio mobile phone machine like a cellular phone access the Internet with various means and visit an internet advertising site It is related with the method and equipment which connect a portable telephone with the Internet and provide an advertisement and charge discount service by the method which the mark equivalent to the number of times and time which it visited are accumulated, and can receive the benefit of portable telephone-rates discount later" – e.g. par. [0002]).

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Hou's wherein an amount obtained by subtracting an advertisement reading fee corresponding to the number of times and frequency of advertisement reading from the internet connection service fee is charged into Takada et al. – Jun motivated by "aims at offering the portable telephone-rates discount method and equipment with which useful information is also obtained at the same time the use charge of a portable telephone is reducible to the user of the Internet" (Hou, par. [0010]).

As per **claim 9**, Hou further discloses wherein the number of times of advertisement reading as the basis of discount computation or a value obtained by

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multiplying the number by a coefficient or a numerical value corresponding to frequency or degree is accumulated and updated as points (e.g. par. [0001] – [0002])

As per **claim 10**, Hou further discloses wherein the points are as well accumulated and updated with respect to said user, who has read advertisements accumulated in ISP managing a system for counting the points from the outside via the internet (e.g. par. [0011] and claim 1)

As per **claims 13-14**, Hou further discloses wherein a status indicating that said user has read advertisements by accessing a system, via the internet, and a distribution history such as the number of times and frequency of the distribution is accumulated and updated for each advertisement of advertisement data and the system is managed by an advertisement management dealer accumulating and processing advertisement data concerning advertisements requested by an advertisement requester, processes distribution record data obtained by recording the number of times and degree of advertisement distribution for obtaining a fee corresponding to the number of times and frequency of the advertisement distribution from the advertisement requester (e.g. par. [0011] and [0033]).

As per **claims 24-26**, they are rejected using the same rationale as for the rejection of claims 8-10.

As per **claim 27**, it is rejected using the same rationale as for the rejection of claim 13.

As per **claim 28**, it is rejected using the same rationale as for the rejection of claim 14.

As per **claims 29-30**, they are rejected using the same rationale as for the rejections of claims 13-14.

11. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takada et al., (U.S. Pub. No. 20020089931) - Applicant's admitted prior art by Jun (Japanese Patent Laid-open 2001-266018. The below rejections are based on the Machine English translation copy provided by Japanese Patent Office) as applied above in claim 1 and further in view of Hou (Japanese 2001-111727A. The below rejections are based on the Machine English translation copy provided by Japanese Patent Office).

Takada et al. – Jun does not expressly disclose wherein advertisement data preliminarily received from the advertisement requester and accumulated are distributed to said user, and a distribution history, such as the number of times and degree of the distribution, is accumulated and updated for each advertisement of the advertisement data.

However, this well known feature of wherein advertisement data preliminarily received from the advertisement requester and accumulated are distributed to said user, and a distribution history, such as the number of times and degree of the distribution, is accumulated and updated for each advertisement of the advertisement data is disclosed in Hou (e.g. par. [0001] – [0002] and par. [0033]).

It would have been obvious to a person with ordinary skill in the art at the time of the invention to incorporate Hou's wherein advertisement data preliminarily received from the advertisement requester and accumulated are distributed to said user, and a distribution history, such as the number of times and degree of the distribution, is accumulated and updated for each advertisement of the advertisement data into Takada et al. – Jun motivated by "aims at offering the portable telephone-rates discount method and equipment with which useful information is also obtained at the same time the use charge of a portable telephone is reducible to the user of the Internet" (Hou, par. [0010]).

12. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takada et al., (U.S. Pub. No. 20020089931) in view of Applicant's admitted prior art by Jun (Japanese Patent Laid-open 2001-266018 and further in view of Applicant's admitted prior art by Kawano (Japanese Patent Laid-open 2001-298484. The below rejections are based on the Machine English translation copy provided by Japanese Patent Office)

As per **claim 31**, Takada - Jun discloses a system as applied above in claim 21.

Takada - Jun does not disclose expressly comprises a QoS (quality of service) unit for controlling a preset QoS for said user's service class, and the service server has a communication quality managing table, in which communication qualities of services are preset.

Kawano discloses comprises a QoS (quality of service) unit for controlling a preset QoS for each user's service class, and the service server has a communication

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quality managing table, in which communication qualities of services are preset (e.g. abstract, paragraph [0015] and [0039]-[0040]).

Accordingly, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to incorporate a QoS (quality of service) unit for controlling a preset QoS for each user's service class, and the service server has a communication quality managing table, in which communication qualities of services are preset to Takada - Jun's system. The motivation of doing so would have been for a user "to choose freely the service conditions of a network service to use at every connection and can specify them when connecting with a network from a user terminal and has the effectiveness of becoming possible to offer the network service according to the service condition", as taught by Kawano (paragraph [0039]).

Response to Arguments

13. Applicant's arguments filed 8 August 2008 have been respectfully and fully considered but they are not persuasive.

14. The Applicant's arguments summarized as below:

- a. Jun fails to teach distributing advertisement data to a user in correspondence to a service class to a user **in correspondence to a service class** in claims 1 and 17 (See Remark page 14)
- b. The dependent claims 2-3, 6-11, 13-16, 18-19 and 22-32 are allowable due to dependency on claims 1 and 17 (See Remark pages)

In response to argument ‘a’, the examiner respectfully disagrees. It appears that the Applicant is not interpreting the previous office action as intended by the examiner.

First, the Applicant is respectfully reminded that One cannot show nonobviousness by attacking references individually where the rejections are based on combination of references. See *In re Keller*, 642 F. 2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Second, in claim 12, Jun discloses “it connected with...**while generating said service information based on said customer information memorized beforehand and transmitting said service information to said consumer premise equipment**”. Further, in paragraph [0030], Jun discloses “...Various processing programs, such as data, such as each vendor’s Q original advertising information, and an information offer processing program for transmitting the predetermined information and the various predetermined messages of goods to Customer P according to the demand from a consumer premises equipment 2..”. Furthermore, “...it becomes easy to provide with goods (service) suitable to the taste of the consumer...” (e.g. par. [0059]). Therefore, it would have been obvious to a person with ordinary skill in the art at the time of the invention that Jun’s customer information can include Takada et al.’s user service class information and incorporating Jun’s advertisement data which have been preliminarily received from an advertisement requester and accumulated are distributed to said users in correspondence to said service class into Takada et al. motivated by increasing an

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opportunity to supply the advertisement of own goods to a customer according to a demand of a customer (Jun, par. [0030] and [0032]).

Therefore, the combined teachings of Takada et al. – Jun discloses distributing advertisement data to a user in correspondence to a service class to a user in correspondence to a service class.

In response to argument 'b', the examiner respectfully traverses. Since independent claims 1 and 17 are not allowable, the rest of dependent claims are also not ready for allowance.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to APRIL Y. SHAN whose telephone number is (571)270-

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1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/April Y Shan/
Examiner, Art Unit 2435
/Kimyen Vu/

Supervisory Patent Examiner, Art Unit 2435